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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 08/941,975

Filing Date: 10-1-1997

Appellant(s): Barraclough

Robert J. Crawford
For Appellant

This is in response to appellant's brief on appeal filed 11-29-2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims Group A: claim 1; Group B: claims 2-5, Group C: claims 7-11, 13; Group D: claim 12; and Group E: claim 14, do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

JP403229588A	Iwasaki	10/1991
5,016,107	Sasson et al.	5/1991

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 6, 12, are rejected under 35 U.S.C 102(a) as being anticipated by Iwasaki (JP4032229588A).

Regarding claim 1, 6, 12, Iwasaki discloses video telephone system comprising: providing a videocommunicator constituted by (1-5, 8-15, fig. 1) having a video input port in 4, a video signal encoding circuit 8 and a video signal output port in 4, and using a digital still camera to generate video input signals to the video input port of the videocommunicator, the video out port of the videocommunicator capable of communicatively coupling to a communication channel for providing videoconferencing, a set-top box constituted by (1-5, 8-15, fig. 1) having a first and second input ports in (4,2) an output port at 4, and the set-top box configured and arranged to output display signals via the output port responsive to control signals at the second input port in 2, an external video camera 7 coupled to the first input port in 4 of the set-top box, configured to and arranged to output video signals, a control unit 4 coupled to the second input port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box, and a display 6 coupled to the output port in 4 of the set-top box to receive display signals (figs. 1-2, see abstract).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5, 7-11, 13, 14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki in view of Sason et al. (US PAT. 5,016,107).

Regarding claims 2, Iwasaki teaches the following: using the videocommunicator to transmit video signals using a video-signal processing circuit 4 (general purpose processing circuit, fig. 2, see abstract); but does not explicitly teach DSP circuit for compression of video data.

However, Sasson discloses electronic still camera utilizing image compression and digital storage which teaches using DSP circuit 22 for compression of video data (fig. 1, col. 6 lines 3-6, col. 4 lines 60-63).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Iwasaki's system to provide for DSP circuit for compression of video data as this would enable the user to select the most desirable compression algorithm to achieve the desired results.

Regarding claim 3-5, Iwasaki teaches the following: digital still camera 7 to provide video signal representing a live target area along with a split screen representing stored stilled image

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(see fig. 2), output of the video communicator in 4 to provide video images for a display 6, other output port in 4 to output video data representing images received from the digital still camera 7 (figs. 1-2, see abstract).

Regarding claims 7, 14, Iwasaki further teaches the following: set-top box constituted by (1-5, 8-15, fig. 1) having a first video input port in 4, and a video output port in 4, and first and second telephone ports at 2 and 1, the set-top box configured and arranged to output video signals via video output port in 4, output local video signals via the second telephone port, and input remote video data signals via the second telephone port, responsive to control signals at the first telephone port at 2, the set-top box having a video signal processing circuit 4, a camera 7 coupled to the first video input port in 4, and configured and arranged to output video signals representative of stored images of the scene captured by the camera 7, a telephone circuit 9 coupled to the first telephone port at 2 and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box, and a monitor 6 coupled to the video output port to receive the video signals and display images represented by the video signals, video signal encoding circuit 8, programmable general purpose processor circuit 2, picture thinning (pan, zoom, and tilt functions) of the video input signals without controlling the digital still camera (figs. 1, 2, see abstract).

Iwasaki differs from the claimed invention by not teaching the following: programmable DSP circuit for video compression.

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However, Sasson discloses electronic still camera utilizing image compression and digital storage which teaches programmable DSP circuit 22 for compression of video data (fig. 1, col. 6 lines 3-6, col. 4 lines 60-63).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Iwasaki's system to provide for programmable DSP circuit for compression of video data as this would enable the user to select the most desirable compression algorithm to achieve the desired results.

Regarding claims 8-11, 13, Iwasaki further teaches the following: set-top box constituted by (1-5, 8-15, fig. 1) having second video input port in 4, a video camera 7 coupled to the second video input port, the monitor 6 having a screen viewing area and the set-top box being responsive to control signals to split the screen to simultaneously display stored images and images represented by the local video signals, and the remote video signals as shown in fig. 2 (figs. 1-2, see abstract).

(11) Response to Argument

Appellants' remarks have been fully considered but they are not persuasive.

1. With respect to appellants' remarks that "Section 132 of Title 35 of U.S. Code explains that whenever any claim for a patent is rejected, the Applicant shall be notified of the rejection along with a statement of reasons for such rejection, "together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application". Examiner has met the burden of providing this information as evidenced by the

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office actions along with references with English abstract for Japanese publication (JP403229588A) to Iwasaki. Due to limited resources available for translation of foreign publications in the office at the time of the office action, examiner has provided necessary information to support rejection along with original Japanese publication with English abstract.

2. Appellants' arguments on rejection of independent claims 1, 6 and 12 under 35 U.S.C. 102(a) as being anticipated by Iwasaki (JP4032229588A): Appellant, with reference to Iwasaki, argues that "its picture processing section 4 has any output port whatsoever or that is capable of communicatively coupling to a communication channel for providing video conferencing". Iwasaki in fig. 1 illustrates picture processing section (4, fig. 1) with an output line that is connected, through system control unit (2) to the line interface circuit (1) that is connected to the ISDN line (20) of fig. 1. This clearly indicates that video processing section (4, fig. 1) with an output line that is capable of communicatively coupling to a communication channel for providing video conferencing. With respect to claims 7-13, Appellant further argues that "the Examiner has erroneously alleged that items 1-5 and 8-15 of the Iwasaki reference constitute a certain type of set-top box". Iwasaki in fig. 1 provide an arrangement with items (1-5, and 8-15) that constitute set-top box as illustrated in fig. 1 with input ports in (4, 2, of fig. 1), input port in (4 of fig. 1) for accepting input from cameras (7 or 16 of fig 1) as clearly shown in fig. 1, input port in (2 of fig. 2) accepting input from telephone (10) and operating part (11 of fig. 1) as clearly shown in fig. 1 and output line in (4, fig. 1) for providing output to the communication line (20 of fig. 1)

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through system control circuit (2) and line interface (1) and also output line in (4) providing output to display (6 of fig. 1) as clearly shown in fig. 1.

Appellant remarks on page 6 (first paragraph) of appeal brief relating to the Iwasaki reference say that “Similarly, each of the claims 7-13, requires set-top box arrangement and , apparently to translation problems, the Examiner has erroneously alleged that items 1-5 and 8-15 of the Iwasaki reference constitute certain type of set-top box. No other information was provided, for example, teaching from the Iwasaki reference that indicates upon what these functional portions reside on, or whether functional portions are even enclosed with each other inside any type of housing”. In fact, it stands to reason to point out that various functional components in fig. 1 of Iwasaki including items 1-5 and 8-15 have to be housed in some form of housing which is implied. In fact appellant’s patent (5,379,351) to which appellant claiming priority shows in fig. 1, various functional portions like (4, 6, 10, 12, 30) connected with each other without any mention about set-top box to house these components.

Appellant repeatedly argues that “ the Examiner has failed to support a rational in support of the position that the cited functional portions 1-5 and 8-15 of the Iwasaki reference constitute a set-top box, or constitute any of the aspects claimed as being part of the set-top box”. Again referring to fig. 1 of Iwasaki reference, arrangement of items (1-5 and 8-15 of fig. 1) constitute set-top box, having input ports in (4, 2 of fig. 1) for receiving inputs from cameras (6 and 16 of fig. 1) and also an output port in (4, fig. 1) for sending outputs to display (5, fig. 1) and to the

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communication line (20, fig. 1) through system controller (2, fig. 1) and line interface (1, fig. 1) as can be clearly seen from fig. 1.

Rejection of claims 2-5, 7-11, 13 and 14 under 35 U.S.C 103(a) over Iwasaki in view of Sassson: Regarding claim 14, Appellant argues that "The office action erroneously alleges at the bottom of page 4 of the Final Office Action that "picture thinning" is same as claimed pan, tilt and zoom functions; no basis is provided for this conclusion". According to claim 14, one of the limitations is as follows: using the videocommunicator for controllably altering a display, including one of pan, tilt and zoom functions, of the video input signals without controlling the digital still camera. This aspect is implied by Iwasaki's abstract which says the following: In a picture processing part 4, the omit processing for the picture information is executed according to a designated number of the pictures to be displayed, and picture information changed in picture size so that plural pictures can be displayed in one screen and picture thinning is supplied to the display part 6 which implies zooming without controlling the digital still camera, because it is adjusting the size of the picture size which is a form of zooming (see abstract of Iwasaki).

Appellant further argues in section (iii) of appeal brief that "another specific example of this deficiencies found in connection with the output port of the set-top box being coupled to pass image signals to the display, as set forth in each of the claims 7-13. At page 2 of the Final Office action ... the Examiner alleged generally that "video output port" can communicatively couple to the video communicator while, in the same sentence, arguing that the first input port 4 is an output port 4 which is also output port for the display. Appellant is misinterpreting what is

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described in the office action of page 2 and Iwasaki reference. Again referring to fig. 1 of Iwasaki, image processing unit (4 of fig. 1) one of the components of the set-top box has an output line in (4 of fig. 1) outputting image data to the display (6, fig. 1) and image processing unit (4) of fig. 1 has an output line communicatively coupled to the system controller (2) which is part of the video communicator constituted by an arrangement of items (1-5 and 8-15 of fig. 1) and providing output to the line (20), thus it is communicatively coupled to the telephone line (20) through system controller (2) and line interface (1).

Appellant remarks regarding claims 7-13 that "At page 2 of the Final Office action, the Examiner defines item 4 as a control unit adapted to receive user inputs for controlling the set-top box. The examiner previously defined item 4 as an input port and also output port". As a preliminary matter, control unit (2, fig. 1 of Iwasaki) was inadvertently indicated as (4, fig. 1 of Iwasaki) as is clear from fig. 1 of Iwasaki reference with a control unit (2, fig. 1 of Iwasaki) which has inputs to accept control signals from the operation part (11) and telephone (10). In fact page 4 of final office action, this is clearly described in rejection of claims 7 and 14.

Regarding claims 2-11, and 13, rejected under 103(a), Appellant argues that "In connection with rejection of claims 2-11 and 13, the examiner has not presented any evidence for the requisite motivation for establishing the asserted combination. Examiner's asserted motivation is only a statement that it is desirable to enable the user to select the most desirable compression algorithm to achieve the desired results. Appellant has not been provided with any citation of to the prior art that would correspond to this desire, and neither asserted reference

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appears even remotely related to this notion of selecting desirable compression algorithm”.

Sassson clearly provide the motivation in that he states “that one desirable consequence of this architecture is that the processing algorithm employed in the compression and recording section may be selected for quality treatment of the image rather than for throughput speed (fig. 1A, col. 4 lines 60-63) as was clearly indicated in the final rejection of Appellant’s claims. This clearly suggests that compression algorithm can be selected to get quality treatment of the image (desired results).

As a matter of fact, the Appellant never throughout the prosecution period once commented about Iwasaki reference or other references used in various rejections of Appellants claims 1-14 until the appeal brief. In fact Appellant was more focused on trying to overcome the art used in the rejection of Appellant’s claims 1-14 by swearing behind the date of the Iwasaki’s reference, leading to the conclusion that the references applicability to the rejection of the appellant’s claims. Now appellant, all of a sudden, making detailed comments about the references used in the rejection of Appellant’s claims which Appellant has not done during prosecution of the application.

With respect to item (vi) of appeal brief, Appellant says that “ Appellant has provided adequate evidence in character and weight, so as to establish reduction to practice prior to the publication data (October 11, 1991) of the reference”. Appellant has provided, under 37 C.F.R. 1.131 declaration, photocopies of generic circuit board drawings with a microprocessor, memory, DMA and I/O ports which shows no clear relationship to the Appellant’s present

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invention and its claims. Appellant further, in paragraph two on page 10 of appeal brief, provides remarks to the effect that "The second of these Declarations (executed July 19,2000) clearly establishes the relationship between the claimed invention of the instant application (Serial No. 941,975), the parent application (now U.S. Patent No. 5,379,351), and the photocopy of the actual prototype board which was attached to each of the Declarations". The declaration provides photocopy of the of generic circuit board drawings with a microprocessor, memory, DMA and I/O ports and statements 1-6 which describe circuit arrangement of fig. 1 in U.S. Patent No. 5,379,351). No more evidence is provided other than this and one of ordinary skill in the art would not be able to relate the Appellant's present invention and its claims to the photocopy of the generic circuit board drawing with a microprocessor, memory, DMA and I/O ports.

Appellant makes further remarks to the effect that "Appellant contests the three conclusory statements behind the examiner's rejection: a) there is no nexus between the drawings in U.S. Patent No. 5,379,351 and the drawings attached to the second of the Declarations The rationale is erroneous and unsupported on several counts". Again examiner reiterates once again, as explained above, that there is no nexus between the drawings in U.S. Patent No. 5,379,351 and the drawings attached to the second of the Declarations and the attached drawings are very generic that are common in any computer related circuit board drawings with a microprocessor, memory, DMA and I/O ports and one of ordinary skill in the art would not be able to relate the Appellant's present invention and its claims to the photocopy of the generic circuit board drawing with a microprocessor, memory, DMA and I/O ports. .

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Appellant further makes remarks, on page 10 of appeal brief in the last paragraph, to the effect that "Second "connection" between the drawings in the U.S. Patent No. 5,379, 351 and the drawings in the instant specification has been provided at length through the "Amendment and response" filed on April 21, 1999. This "connection includes a claim chart aligning claim 1 of the instant application with the specification and drawings of U.S. Patent No. 5,379,351". Appellant did not include in the claim chart claim limitation relating to the other independent claims 7 and 14. In fact claim 7, recites the following limitation: "a telephone circuit coupled to the first telephone port and configured and arranged to receive user control inputs and, responsive there to, provide control signals to the set-top box;". U.S. Patent No. 5,379,351, which the Appellant claiming priority to has no disclosure to support this claim limitation. As regards other claim 14, it recites the following limitation: "using the videocommunicator for controllably altering a display, including at least one of pan, tilt, and zoom functions, of the video input signals without controlling the digital still camera. Again U.S. Patent No. 5,379,351, which the Appellant claiming priority to has no disclosure to support this claim limitation. These are just few examples of claim limitations of the Appellants present invention and lack of disclosure of these elements in the U.S. Patent No. 5,379,351, which the Appellant is claiming priority to.


Conclusion


For the above reasons, the examiner respectfully submits that a *prima facie* case of anticipation and obviousness of the claimed invention has been set forth in the Final office action

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and appellant(s) has/have failed to overcome the *prima facie* case of rejections. Accordingly, it is believed that the Final rejection under 35 U.S.C. 102 and 103 is proper and Board of Patent Appeals and Interferences is therefore respectfully urged to affirm the Examiner's rejection (s). Further the examiner respectfully submits that Appellant's claim to priority to U.S. Patent No. 5,379,351, has no basis whatsoever as explained above and accordingly the examiner respectfully submits to Board of Patent Appeals and Interferences that it should not be granted.

Respectfully submitted,


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